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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,508	01/23/2004	Izhar Halahmi	4707-002	5241
23429 7590 02/25/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER ANTHONY, JOSEPH DAVID				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,508

Applicant(s)

HALAHHI ET AL.

Examiner

Joseph D. Anthony

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/25/08 as RCE and amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION AFTER FILING RCE.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 17-23 are rejected under 35 U.S.C. 102(e) as anticipated by, or in the alternative, as being obvious under 35 U.S.C. 103(a) over Ahsan U.S.

Patent Number 6,822,341.

Ahsan teaches a latent catalyst particularly useful in epoxy molding compositions for use in electronic packaging materials is provided. The latent catalyst is in the form of a curative represented by a combination of an inorganic-based carrier having an activated surface and a catalyst compound including a moiety capable of accelerating curing of the epoxy resin, such as the reaction product of silica and 1,8-diazobicyclo(5.4.0)undecene-7 (DBU). Other disclosed inorganic-based carriers, which are preferably in the nano-scale range are calcium carbonate, wollastonite, montmorillonite, clay, mica, kaolin ect., see column 5, lines 27-42. Other disclosed catalysts are nitrogen-containing compounds such as amide compounds and/or imidazole compounds, see column 5, line 43 to column 7, line 8. The inorganic-based carrier is about 60 to about 90 weight percent of the produced curative, while the catalyst is about 10 to about 40 weight percent of the produced curative, see column 7, lines 11-20. The activated surface of the inorganic-based carrier includes reactive surface groups capable of bonding to the moiety through a hydrogen bond, and also includes a high surface area porous surface, such that the catalyst compound is sorbed on the activated surface. The invention further provides epoxy compositions including the curative with an epoxy resin and a curing agent for the epoxy resin, which compositions are particularly useful as molding powders for semiconductors with

prolonged shelf life stability, see abstract. Applicant's claims are deemed to be anticipated over the said cited sections of Ahsan's Patent.

In the alternative, Ahsan can be said to differ from applicant's claimed invention in that there does not seem to be a direct teaching (i.e. by way of a specific example) of a curative that comprises a catalyst agent that falls within applicant's claimed curing agents. It would have been obvious to one having ordinary skill in the art to use Ahsan's disclosure to imidazole compounds as highly effective catalysts as strong motivation to actually use imidazoles in the production of the curative product.

Claims 1-2 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Correll et al. U.S. Patent Application Publication No.: 2004/0230008A1.

Correll et al. teach a powder composition in multiple separate parts comprising one or more than one resinous powder component in one or more than one part and, for each resin component, one or more than one powder, liquid or gaseous curing agent component in one or more than one separate part, wherein the average particle size ratio of each resinous powder component to its curing agent powder or droplet component ranges from 1.3:1 to 60:1 to insure the attraction of the resin and its curing agent to one another. Useful resins may include epoxy resin, polyester resin or their combination. The shelf life of the powder composition can be extended indefinitely by storing each resin and its curing agent in separate parts. However, each resin and its curing agent react within a period of from 0.01 to 600 seconds to form a cured powder coating when combined at a temperature of from 20.degree. C. and 200.degree. C. to

enable very low temperature cure. In addition, the present invention provides a method of forming a powder coating from the inventive composition which comprises combining each of the separate parts in stream while or by applying them to a substrate, for example, as two or more than two separate feed streams from a single applicator device, followed by curing, see abstract. The curing agent can be made from a nitrogen-containing curing agent, such as dicyandiamide or imidazoles, that may be adsorbed onto an inorganic carrier such as silica, wollastonite, diatomaceous earth and talc, to form a powdery component, see sections [0051] and [0053].

Correll et al. can be said to differ from applicant's claimed invention in that there does not seem to be a direct teaching (i.e. by way of a specific example) of a powdery component comprising a nitrogen-containing curing agent support on an inorganic carrier. It would have been obvious to use the direct disclosure of said cited reference sections as strong motivation to actually make a powdery component that comprise one of applicant's claims curing agents supported on one of applicant's claimed inorganic support material.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 17-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-30 of copending Application No. 10/757,175. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is massive overlap in the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 1/25/08 with the RCE and Amendment have been fully considered but they not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next. Contrary to applicant's arguments over the applied Ahsan Patent, the Examiner notes the following: 1) Ahsan directly discloses curing agents that read on applicant's claimed curing agents, and 2) Ahsan directly discloses the use of an excess of the inorganic carrier over the catalyst component.

Prior-Art Cited But Not Applied

Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

/Joseph D. Anthony/

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Primary Examiner, Art Unit 1796